

Notice of Allowability**Application No.**

10/694,273

Applicant(s)

SINGH ET AL.

Examiner

AMINA KHAN

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/11/2008.
2. ☒ The allowed claim(s) is/are 54,55,61-65,69,76,77,79,81,82,85,91-96,98,99 and 130-132.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☒ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 12/11/08
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date 12/17/08.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

/DOUGLAS MC GINTY/
Primary Examiner, Art Unit 1796

Oath/Declaration

1. Applicant is now required to submit a substitute declaration or oath to correct the deficiencies set forth. The applicants claim priority to provisional applications 60/421,263 and 60/421,435 which have a priority date of **10/25/2002**, however in the OATH the provisional date of these applications is given as **10/25/2003**. The date must be corrected and changed to **10/25/2002**. The substitute oath or declaration must be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability" (PTO-37). Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136. Failure to timely file the substitute declaration (or oath) will result in **ABANDONMENT** of the application. The transmittal letter accompanying the declaration (or oath) should indicate the date of the "Notice of Allowance" (PTOL-85) and the application number in the upper right hand corner.

EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Joe Posillico on December 17, 2008.

3. The application has been amended as follows:

- a. In claim 54, lines 3-4, delete "a fluorinated propene having no substantial acute toxicity said fluorinated propene comprising"
- b. In claim 54, line 5, after "(HFO-1234yf)" add --having no substantial acute toxicity--
- c. In claim 61, line 3, replace "compatablizer" with --compatabilizer--
- d. In claim 62, line 1, replace "51" with --54--
- e. In claim 79, line 1, replace "ODP" with -- ozone depletion potential (ODP) --
- f. In claim 82, line 2, replace "compatablizer" with --compatabilizer--
- g. In claim 82, line 3, replace "pentane," with --pentane--
- h. In claim 85, line 2, replace "compatablizer" with --compatabilizer--
- i. In claim 92, line 1, replace "COP" with --coefficient of performance (COP)--
- j. In claim 93, line 2, before "lubricant" add --said--
- k. In claim 96, line 3, replace "COP" with --coefficient of performance (COP)--
- l. In claim 130, lines 1 and 2, replace "wherein said fluorinated propene consists" with --consisting--
- m. In claim 130, line 2, before "HFO-1234yf" add --said--
- n. In claim 130, line 2, after "HFO-1234yf" add --and said lubricant--
(basis for amendment found in claim 54)
- o. In claim 132, lines 1 and 2, replace "wherein said fluorinated propene consists" with --consisting--
- p. In claim 132, line 2, before "HFO-1234yf" add --said--

- q. In claim 132, line 2, after "HFO-1234yf" add --and said lubricant--
(basis for amendment found in claim 54)

REASONS FOR ALLOWANCE

4. The following is an examiner's statement of reasons for allowance: The claims are allowable over the closest prior art of record, Smits (US 4,945,119) in view of Aoyama et al. (US 5,679,875) due to applicant's showing of unexpectedly superior toxicity properties of the combination of HFO-1234yf and the ND-8 lubricant in the declaration filed December 11, 2008.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMINA KHAN whose telephone number is (571)272-5573. The examiner can normally be reached on Monday through Friday, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amina Khan/
Examiner, Art Unit 1796
December 18, 2008

/DOUGLAS MC GINTY/
Primary Examiner, Art Unit 1796